6173/20US

REMARKS

Claims 1-13, 15-30, and 32-39 are pending in this application. Claims 1, 4, 6, 7, 9-11, 15, 16, 21, 23, 24, 26-28 and 32 have been amended by this Amendment.

The Office Action March 30, 2004 rejected claim 7 as being indefinite under 35 U.S.C. 112, second paragraph, and rejected claims 1-4, 6-8, 18-21, 23-25, 32, 33 and 35-39 as being anticipated by U.S. Published Patent Application No. 2003/0073440 to Mukherjee et al. The Office Action also rejected claims 10-13 and 15-17 as being obvious over Donovan ("IMPS – Instant Messaging and Presence Using SIP") in view of Holmes-Kinsella (U.S. Patent Application Publication No. 2002/0147000), and rejected claims 27-30 as being obvious over Rosenberg in view of Holmes-Kinsella (U.S. Patent Application Publication No. 2002/0147000). Applicant gratefully acknowledges the indication that claims 5, 9, 22, 26 and 34 are allowable.

Indefiniteness Rejection

The rejection of claim 7 as being indefinite under 35 U.S.C. 112, second paragraph, is set forth in part 4 on page 3 of the Office Action. Specifically, claim 7 is rejected as being indefinite on the grounds that there is insufficient antecedent basis for the limitation "said previous mobile terminal". Claim 7 has been amended by this Amendment and claim 7, as amended, refers to "said previous user terminal" which has proper antecedent basis. Applicant therefore respectfully submits that the rejection has been overcome by the amendment to claim 7.

11

BRMFS1 451623v1

Claim Amendments

In the previous Amendment filed on December 8, 2003, applicant argued that the term "service information" meant that information which is utilized to allow the user to continue their communication services at a new or recovered terminal and could not be anticipated by the presence data. However, in part 1 on page 2 of the outstanding Office Action, the arguments were found unpersuasive although consistent with the specification. Consequently, applicant has amended the claims to clarify the invention by explicitly including the referenced language regarding the service information. Applicant respectfully submits that the claims, as amended, are now in immediate condition for allowance for the reasons stated previously that the prior art methods and systems using presence data applied in the rejections do not disclose or suggest the features related to the service information recited in the claims.

Anticipation Rejection

The grounds for the rejection of claims 1-4, 6-8, 18-21, 23-25, 32, 33 and 35-39 as being anticipated by U.S. Published Patent Application No. 2003/0073440 to Mukherjee et al is set forth in part 6 on pages 4-8 of the Office Action. The rejection relies upon the embodiment shown in Figs. 2 and 7A and described in paragraphs 49-52, 85-101, and 115-117 of the patent (this embodiment hereinafter being referred to simply as "Mukherjee"). Applicant respectfully traverses the rejection at least because it does not establish a prima facie case that Mukherjee includes each and every one of the combination of features recited in the independent claims 1 and 32.

6173/20US

Mukherjee relates to determining and sending presence information relating to the capabilities and configuration of a terminal. As explained above with respect to the claim amendments, the presence information in Mukherjee is not service information as recited in the claims and therefore Mukherjee cannot anticipate the rejected claims for this reason.

Furthermore, independent claims 1 and 32 recite features related the process of requesting service information from a registrar or proxy server from a new or recovered user terminal. Although Mukherjee does describe a process that exchanges information using SIP based messages and SIP messages are recited in some of the dependent claims, the process involved in Mukherjee does not suggest the process features recited in claims 1 and 32.

Obviousness Rejections

The grounds for the obviousness rejection of claims 10-13, 15-17 and 27-30 as being obvious over Donovan ("IMPS – Instant Messaging and Presence Using SIP") or Rosenberg in view of Holmes-Kinsella (U.S. Patent Application Publication No. 2002/0147000) is repeated forth on pages 8-11 of the Office Action. In addition to the reasons set forth above with respect to the claims amendments, applicant again respectfully submits that the obviousness rejection fails to establish a prima facie case that the proposed combination of cited references suggest each and every one of the features recited in the rejected claims.

The patent to Holmes-Kinsella is directed to associated devices to a user's account and allows a user to designate an additional device to receive subscribed services so that there may be multiple devices authorized for a customer account. This is fundamentally different than the claimed invention because it operates on the premise of identifying terminals rather than having service information be provided upon identification of a user using the device. Holmes-Kinsella

13

BRMFS1 451623v1

thus **directly teaches away** from the claimed invention. It suggests that a user should be enabled to utilize multiple devices by having device identifiers added to a subscriber account. It also requires action to be taken by the user in adding the device to the account whereas in the claimed invention the subscribe message enables the user to use a new or recovered terminal without taking such action.

The Office Action states that paragraphs 22, 23 and 25 of Holmes-Kinsella teaches providing a request for service information and providing service information in a single message in response to the request. However, the service provider does not receive a request for service and has to prompt the user to add the device to the account (step 316 in Fig. 3). This is the prior art (see paragraph 8 of the specification) and stands in contrast to the claimed invention. The user does so using a different device than the device being added by providing account identification. Even so, Holmes-Kinsella appears to merely authenticate and authorize the new device, and there is no description of it sending service information as recited in the claims.

There is no reason that one of ordinary skill in the art would attempt to modify either of Donovan or Rosenberg according to Holmes-Kinsella in the limited manner proposed in the rejection were it not for the hindsight provided by this application in attempting to meet all of the limitations of the claims. One of ordinary skill in the art would conclude from Holmes-Kinsella that a user should be enabled to use different terminals by adding device identifiers to the user's account, rather than by the method recited in the claims. The last sentence in part 2 on pages 2-3 of the Office Action generally asserts that Holmes-Kinsella teaches making the modification to the method recited in the claims, but can not point to the motivation in Holmes-Kinsella.
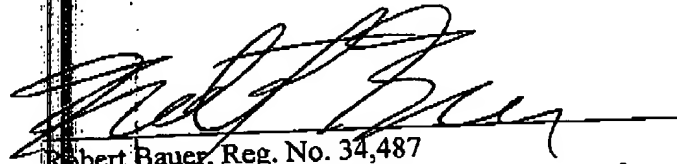
14

BRMFS1 451623v1

6173/20US

Conclusion

Applicant respectfully submits that the rejections fail to establish that the claims are anticipated or rendered obvious by the prior art. It is respectfully requested that each one of pending claims 1-13, 15-30 and 32-39 be allowed and a formal Notice of Allowance be promptly mailed.

Please charge any fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 02-4270 (6173/20US) and please credit any excess fees to such deposit account.

Respectfully Submitted,

Robert Bauer, Reg. No. 34,487
BROWN RAYSMAN MILLSTEIN FELDER &
STEINER LLP
900 Third Avenue
New York, NY 10022
Tel: (212) 895-2000
Fax: (212) 895-2900

15

BRMFS1 451623v1